

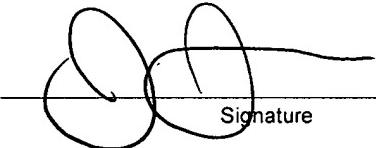
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 868A.0074.U1(US)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on <u>November 3, 2011</u>  Signature <u>Elaine F. Mian</u>  Typed or printed name <u>Elaine F. Mian</u>		Application Number 10/576,536	Filed 4/19/2006
		First Named Inventor Juha Karttunen	
		Art Unit 2629	Examiner Stone, Robert M.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>60,564</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		 <p>Signature Juan Juan</p> <p>Typed or printed name</p> <p><u>203 925-9400</u></p> <p>Telephone number</p> <p><u>November 11, 2011</u></p> <p>Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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### Arguments Accompanying Pre-Appeal Brief Request for Review

Claims 1-3, 5-15, 17, and 19-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshiki (JP 2003062268) in view of Yokoi (US 4,542,903) and Halo: Combat Evolved (User's Manual). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshiki (JP 2003062268) in view of Yokoi (US 4,542,903) Halo: Combat Evolved (User's Manual), and Kawai (US 2004/0229691). Applicant respectfully requests reconsideration of these rejections.

Applicant notes that due to the five page limit for attached sheets of the Pre-Appeal Brief Request for Review, only independent claims 1, 9, and 19 will be discussed below.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Independent claim 1 recites, in part, (emphasis added) an apparatus comprising ... information-indicating light units are arranged to indicate information concerning a display unit application object located only outside a current view of the display unit so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus ...and the light units are located around the display unit.

Similar to independent claim 1, independent claims 9, 19 recite, in part, respectively (emphasis added):

9. A method comprising ... controlling the information-indicating light units, which are located around the display unit .... such that information concerning a display unit application object located only outside the current view of the display unit is indicated by the information-indicating light units so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus.

19. An apparatus comprising .... a display unit application located only outside the current view of the display unit so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus, wherein the light units are located around the display unit.

The examiner admits that Yoshiki in view of Yokoi does not disclose the indication of objects located only outside the current view of the display so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus, and relies on Halo for this teaching.

In particular the examiner relies on pages 13 and 15 of Halo as disclosing a gaming system with indications at edges of the display and references “large red warning indicators [I] at edges of the screen”. However, applicant submits that the element I on page 13 is actually **an arrow drawn on the display screen**. Firstly, **the element I does not correspond to any information-indicating light unit that could be around the display, as the arrow is an effect produced by the display itself**. Secondly, **the arrow is in the display itself**. The XBOX is a game console to be connected to a television or other display. There is no teaching or disclosure about setting up lamps or other light units around the display. The XBOX game HALO altogether lacks the structure of claim 1.

**Therefore, Halo does nothing to cure the deficiencies in the disclosures of Yoshiki and Yokoi.**

Furthermore, applicant submits that there is no suggestion to combine the references as the examiner is attempting to do (at least not until after reading applicant’s patent application). Applicant previously argued that Yokoi and Yoshiki would not have led an ordinarily skilled person to try making the device of Yoshiki into portable form. In particular, the Examiner contends in the Office Action that Yokoi would provide motivation to produce a gaming device that is as compact as possible (based on col. 1, lines 10-16 and lines 25-26). However, the Yokoi disclosure is not related to gaming devices as a whole, but to a **hand-held** game apparatus where characters are moveable for playing a game. Yokoi’s disclosure is related to making handheld games more compact. It is respectfully submitted that Yokoi fails to provide an overall teaching to make all types of games portable. The Pachinko game of

Yoshiki is not of such nature that a skilled person would have thought of that game when reading the teaching of Yokoi to make handheld games more compact.

Applicant further submits that **the examiner has not shown** why the ordinarily skilled person would have added the information-indication lights surrounding the display to form *a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the stimulus*. Applicant submits that the skilled person would not have been motivated due at least in part to the feature discloses in the present application:

“For example in game applications, the user has time to react to the approaching situation, when the approaching situation is indicated in advance, so that the user can prepare himself for the situation. The location and/or direction of a situation, information, function or the like, left outside the current view, is typically indicated by controlling the light units arranged around the display, so that there are lighted up those light units that are located in the same direction with respect to the display view as the information to be indicated” (see page 4, lines 6-12).

This advantage or objective of reaching this advantage has not been identified in any one of the cited references. Hence, the ordinarily skilled person **would not have had a motivation to construct an apparatus as in claim 1** without use of the claimed invention as a blueprint, nor would he have been able to arrive at the claimed invention solely using the disclosure of the references.

On the Continuation sheet of the Advisory Action, the Examiner appears to argue that the advantage stated in the present application (see second paragraph of Examiner’s arguments, regarding having time to react) is disclosed by Halo.

Firstly, applicant submits that the Direction of Fire indicator merely allows a player of the game determine a direction after receiving enemy fire. In particular, the player of the game can see the ‘view of the world’ on the display screen (Heads Up Display) and therefore when the player sees enemy fire on the screen, the Direction of Fire indicator merely indicates the direction of the received enemy fire (see pages 13, 15). In other words, the Direction of Fire

indicator merely provides some additional information for something already displayed on the screen. Applicant's claimed invention, on the other hand, claims 'an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus'.

Applicant submits that, based on games in general, even if the arrows may indicate the direction of *some danger* outside the current view, applicant fails to see how the arrows would implement the claimed feature of "information indicated light units are arranged to... so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus", if these arrows were implemented by the lights of Yoshiki. Being able to prepare to a danger in a game by knowing its direction does not disclose how the view continues in that direction. For example, the player does not even know what will be there behind him or elsewhere outside the view [when the Direction of Fire indicator appears], in which case it is clear that the arrows do not suggest or provide any "indication of how the view shown on the display continues outside the view". Instead, the player of Halo only has some indication of what direction the enemy fire (which is already on the display screen) came from.

Hence, it is clear that the present rejections do not show *prima facie* obviousness nor can the claimed invention be obvious at all as it is simply impossible to construe the claim 1 from the cited references.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01, page 2100-98, column 1). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP 2143.01, page 2100-98, column 2). A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a

prima facie case of obviousness without some objective reason to combine the teachings of the references. (see MPEP 2143.01, page 2100-99, column 1) Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). >See also Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)

In the present case, there is no teaching, suggestion, or motivation, found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to provide apparatus comprising ... information-indicating light units are arranged to indicate information concerning a display unit application object located only outside a current view of the display unit so that there is formed a visual stimulus that functions as an indication of how the view shown on the display continues outside the view, in the direction of the visual stimulus ...and the light units are located around the display unit, as claimed in claim 1. The features of claim 1 are not disclosed or suggested in the art of record. Therefore, claim 1 is patentable and should be allowed.

For at least the foregoing reasons, independent claim 1 is patentable over Yoshiki in view of Yokoi and Halo. As mentioned above, similar recitations as those for claim 1 are present in independent claims 9, 19. Therefore, all other independent claims (i.e. claims 9, 19) also are patentable over Yoshiki in view of Yokoi and Halo for corresponding reasons regarding correspondingly recited subject matter.

Accordingly, as all independent claims are patentable, all pending dependent claims also are patentable at least in view of their dependency from an allowable independent claim.

For completion, it is respectfully noted that the addition of Kawai, which was cited in the rejection of dependent claim 16, does not cure the shortcomings noted above regarding Yoshiki in view of Yokoi and Halo, and thus no combination of the cited references discloses or suggests Applicant's claimed subject matter.

For all of the foregoing reasons, it is respectfully submitted that all of the claims in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested.